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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,037	11/02/2001	William D. Morgan	IAEC:006US/MTG	1213

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AUSTIN, TX 78701

EXAMINER

MENON, KRISHNAN S

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,037

Applicant(s)

MORGAN ET AL.

Examiner

Krishnan S Menon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE of 9/15/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,9-18,20-25 and 28-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,9-18,20-25 and 28-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claims 1,2,5,6,9-18,20-25 and 28-34 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1,2,5,6,9-18,20-25 and 28-34 are rejected under 35 U.S.C. 102(b) as anticipated, or in the alternative, under 35 USC 103(a) as obvious as being on public use and/or sale in this country by the applicants more than one year prior to the date of application for patent.

Instant claims are directed towards a device as shown in the references C2 – C13 as admitted by the applicant in the IDS of 2/17/04 as on sale or public use more than one year before the filing date of the application. The only element of the claims not clearly seen in these references is the service opening of claims 14,15 and 24-27, which is shown by drawing 1-5, "Access Hatch" in reference C1, which is a proposal dated Nov 8, 1984, to build a membrane cover according to the specification provided by the solicitor (purchaser), and which belongs to a company by name ADI. It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of C1 in the teaching of C4 to provide access ports for sampling or service equipment.

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With regard to the vent holes, C13 seems to be an enlargement of the circles portion of C4, and C13 shows the vent holes as claimed. Even if this is not the case, reference C2 shows direct venting, and therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of C2 in the teaching of C4 for venting the gases accumulated under the membrane to keep the membrane floating on the surface of the pond.

Applicants' declaration regarding the disclosure to Lemna Corporation is moot because, according to MPEP, public use or sale could be a "secret sale or offer to sell".

MPEP 2133.03

35 U.S.C. 102(b) "contains several distinct bars to patentability, each of which relates to activity or disclosure more than one year prior to the date of the application. Two of these - the public use' and the on sale' objections - are sometimes considered together although it is quite clear that either may apply when the other does not." *Dart Indus. v. E.I. du Pont de Nemours & Co.*, 489 F.2d 1359, 1365, 179 USPQ 392, 396 (7th Cir. 1973). There may be a public use of an invention absent any sales activity. Likewise, there may be a nonpublic, e.g., "secret," sale or offer to sell an invention which nevertheless constitutes a statutory bar. *Hobbs v. United States*, 451 F.2d 849, 859- 60, 171 USPQ 713, 720 (5th Cir. 1971).

It should be noted that 35 U.S.C. 102(b) may create a bar to patentability either alone, if the device in public use or placed on sale anticipates a later claimed invention, or in conjunction with 35 U.S.C. 103, if the claimed invention

would have been obvious from the device in conjunction with the prior art.

LaBounty Mfg. v. United States Int'l Trade Comm'n, 958 F.2d 1066, 1071, 22
USPQ2d 1025, 1028 (Fed. Cir. 1992)

2. Claims 1,2,5,6,11-13,16-18 and 21-23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wilson et al (US 4,438,863).

Claim 1: Wilson teaches a pond covering system with a membrane (figures, col 3 lines 3-7) having floatation members covered by the membrane (col 3 lines 20-54; 22,28-fig 4; fig 1; col 3 lines (26-29) and plurality of gas relief vents (col 3 lines 30-43; at 34-fig 4). With ref to fig 4, consider the membranes 10 on the right side as the first membrane, the float 22 on the left side as the first float and the sleeve 28 covering the float 22 as the compartment membrane. In this scenario, the gas passage between the strips 34 and through hole 38 in pipe 36 the gas passage *within the first membrane and adjacent the first flotation member*. (The claim does not recite that there are plurality of holes in the membrane adjacent the first floatation member). Considering another way, the first membrane would comprise membrane 10 on either side of the float, the first float would comprise all the floats 22 and the pipe 36, the membrane (sleeve 28) covering the floats and the pipe would be the float compartment membrane, and the passage between the strips 34 through holes 38 into the pipe 36 would be plurality of gas passage-ways positioned *within the first float compartment membrane*.

Claim 16 defines a first membrane, a second membrane, a float whose width is less than 25% of the first membrane, and a gas relief vent defined by and between the

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first and second membrane. The floats (22-fig 4) which are completely covered by the membrane (28, which is of material same as that of 10) have space 32 between them forming a gas-collecting channel, with the spaces between the straps (34) and vent openings (38) carrying the gas to the gas pipe (36). The membrane is 10, and there are two of them – to the left and to the right of the floats 22. Floats 22 are narrower than the membrane (width <25% of the membrane). Therefore, as recited in claim 16, first and second membranes are coupled, with the gas relief passages between them. The Wilson gas vent cover is also configured to directly vent gas to the atmosphere through at least one gas relief openings – see 66 fig 2 and col 5 lines 29-32.

Claims 2,5,17,18: The first float (22) is sealed in the first float compartment membrane (28). The float compartment membrane and the first membrane are coupled – see fig 4.

Claim 6: The gas relief passage is elevated above the membrane level (see fig 2 and 4).

Claims 11-13, 21-23: The membrane is anchored by an anchor system as in instant claim 11 and 21 (col 3 lines 20-25), which comprises connectors coupled to the edge of the membranes as in instant claim 12 and 22 with sleeves as in instant claim 13 and 23 (20 fig 2).

3. Claims 28-32 are rejected under 35 USC 102(b) as anticipated by or in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Wilson (863).

Wilson (863) teaches a method for venting pool with providing a membrane pool cover having one or more membranes and float supports sealed in the membrane, and with a series of gas vent passages as in instant claims 28-32 (see figures 1-10 and col 3 line 3-col 6 line 58, and the rejection of claims 1 and 16 for more details). Wilson also teaches venting directly to the atmosphere in col 5 lines 29-32, and vent 66 of fig 2. Thus Wilson anticipates venting through vent 66 in fig 2. If not, it would be obvious to one of ordinary skill in the art at the time of invention that the gas collected through the gas pipe 36 could be vented directly to the atmosphere, if separate collection of the gases is deemed unnecessary.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9,10,14,15,20,24,25,33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (863) in view of Ref C1 of the IDS of 2/17/04.

Wilson teaches a pond covering system with a membrane (figures, col 3 lines 3-7) having floatation members covered by the membrane (col 3 lines 20-54; 22,28-fig 4; fig 1; col 3 lines (26-29) and plurality of gas relief vents (col 3 lines 30-43; at 34-fig 4). With respect to fig 4, the first membrane would comprise membrane 10 on either side of the float, the first float would comprise all the floats 22 and the pipe 36, the membrane

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(sleeve 28) covering the floats and the pipe would be the float compartment membrane, and the passage between the strips 34 through holes 38 into the pipe 36 would be plurality of gas passage-ways positioned *within the first float compartment membrane*.

Wilson has more than one floatation member as in claim 9 – see fig 7.

Wilson does not teach the elongated weight positioned between the first and the second floatation members as in claims 9 and 10, and the service opening in the rest of the instant claims. Drawing 1-3 of ref C1 shows such elongated weights. It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of C1 to provide the elongated weights to direct the biogas to the gas passageways in the floats as suggested by the C1 ref, page 3. Drawing 1-5 “Access Hatch” of the ref C1 teaches an access opening with edge support floatation members and membrane coupled to the service opening extending down through the opening and having ballast weight attached. It would be obvious to one of ordinary skill in the art at the time of invention to use the teachings of ref C1 in the teachings of Wilson (863) to provide stable service openings for providing mechanical equipment, etc. Moreover, the reference C1 shows that the inventors had prior knowledge of the need for the elongated weights and the service openings, and this was not part of their invention.

5. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (863) in view of Ref C2 of the IDS of 2/17/04.

Wilson teaches a pond covering system with a membrane (figures, col 3 lines 3-7) having floatation members covered by the membrane (col 3 lines 20-54; 22,28-fig 4;

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fig 1; col 3 lines (26-29) and plurality of gas relief vents (col 3 lines 30-43; at 34-fig 4).

However, Wilson does not teach gas relief passages linking the top and bottom surfaces (as in holes cut through the membrane) of either in the first membrane or in the first float compartment membrane as claimed. Ref C2 teaches discontinuities in the float cover membranes between the floats in the figure in the first page for gas relief and for rainwater drain. It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of C2 in the teaching of Wilson to provide the passage between the top and bottom surfaces of the membrane because it would help drain the rain water collected down in to the pond and also work as a gas vent. One would use the teaching of C2 in Wilson also if the gases liberated can be directly vented to the atmosphere and need not be collected for processing or disposal to reduce the cost of the pond cover.

Response to Arguments

Applicant's arguments filed 9/15/04 have been fully considered but they are not persuasive.

With regard to the rejection based on the statutory bar on public display, sale or offer to sell more than one year before the filing date, an affidavit stating that the actual offer of sale happened not more than one year prior to the effective filing date of the application is required to overcome this rejection. Attorney's arguments are not sufficient. See 37 CFR 1.131.

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In response to applicants arguments against the anticipatory rejection of claims 1, 16, etc., more clarification is given in the rejection. In the claims, Applicant recite gas passageways, which is anticipated by Wilson. In the arguments, applicants argue that what they meant was, to paraphrase, holes in the membrane adjacent to the floats, but that is not what is being claimed. In claims 28-32, venting is through at least one relief openings, which can be any opening, not necessarily the one of the plurality of holes next to the floats, and Wilson has holes in the periphery, which are open to the atmosphere.

Conclusion

This is in response to an RCE filed 9/15/04, and is made non-final due to the new grounds for the rejection of claims 9,10 and 20.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Krishnan Menon
Patent Examiner


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